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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,376	02/27/2002	Daisuke Miyakoshi	112066	4770
25944	7590	11/04/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			TO, TUAN C	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/083,376	<b>Applicant(s)</b> MIYAKOSHI ET AL.	
	<b>Examiner</b> Tuan C. To	<b>Art Unit</b> 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-26 is/are pending in the application.
- 4a) Of the above claim(s) 9, 13-21 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, 10-12, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/07/04, 06/02/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1, 2, 4-8, 10-12, 22, and 23 in the applicant's remarks dated on 08/17/2005 is acknowledged. The traversal is on the ground(s) that the adequate reasons of restriction requirement do not appear on the record. This is not found persuasive because the following:

There are three different independent inventions existed in the present invention:

Invention I: Group I, claims 1, 2, 4-8, 10-12, 22, and 23, drawn to an apparatus, classified in class 701, subclass 35.

Invention II: Group II, claims 9, 13, 14, 15, and 24, drawn to a process, classified in class 701, subclass 210.

Invention III: Group III, claims 16-21, 25, and 26, drawn to a product, classified in class 369, subclass 30.04.

The inventions II and I/III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by a materially different apparatus, such as a navigation apparatus that instruct a user traveling on an optimum route in according to the current location of the user and traffic information received from a traffic center.

Inventions III and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process. For example, the product as claimed can be used in the process of retrieving an optimum route to a destination and displaying said route on a display screen, and that a user is instructed to travel on said route from the user's current location.

The requirement is still deemed proper and is therefore made FINAL

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 2, 4-6, 10-12, 22, and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Bates et al. (US 20010055974A1).

With respect to claim 1, the U.S reference No. '974A1 to Bates et al. has been cited as teaching a system and method for selectively ringing one or more lane phones or portable phones based on the geographic position of a portable phone. A portable phone (100) (Bates et al, figure 1), which is the claimed portable information terminal, shows that the position detector (220) is the claimed receive unit, provided for determining the geographic position of the portable phone; the memory (230), which is the claimed storage unit, is the combination of volatile memory and non-volatile memory for storing location information (geographic region) and parameters to go along with each geographic location. Bates et al. disclose "the data being correlated with last location information received by the receive unit, and when received location information is different from last received location information, extracting data on the current received location information from among data stored in the storage unit". It is truth because the mentioned storage unit (230) stores the location data and correlates the data with the received location information received from the unit (220) (Bates et al, page 3, paragraph 0036). When a user who carrying the portable phone to a new location that is different from the location information, the data belongs to that location would be retrieved. Bates et al. also disclose a display (130) for notifying a user of the information the data that belongs to a geographic location that has been stored in the portable phone. Thus, Bates et al. additionally discloses the limitation: "an information notification unit to notify a user of the portable information terminal of information corresponding to the extracted data. In addition, the microphone (150) is considered as the data obtaining device as claimed in the present invention.

With regard to claim 2, the reference to Bates et al. as discussed above, discloses that the storage unit (230) stores and correlates data and location information received by the unit (220). In figure 2 of Bates et al., there is included a keypad (120) is ready for user to instruct the data stored in the storage unit (230).

With respect to claim 4, the position detector (220) as represented herein is the claimed receive unit for receiving location information; the memory (230) is the claimed storage unit. A user uses one of the keys of key pad(120) to instruct the storage unit to store data. The storage unit (230) correlates and stores the data (telephone parameters) and location information received by the position detector unit (220).

With respect to claim 5, the keypad (120) represented above herein includes a variety of keys for user to select either a location information or data from different pre-stored location information, and data stored in the memory (230) (page 2, paragraphs 0032, 0034). The storage unit (230), as illustrated in Bates et al, stores and correlates the data and the geographic region select by the user (Bates et al, page 3, paragraphs 0035, 0036).

With regard to claim 6, figure 1 of Bates et al. shows that the notification unit includes the display (130), and speaker (140). Therefore, the teachings of Bates et al. read on the limitation "wherein the information notification unit is a liquid crystal display for displaying an image corresponding to the data, or is a speaker for outputting sound corresponding to the data.

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With regard to claims 10-12, the position detector (220) is illustrated in Bates et al. as a GPS receiver, and that the location information is obtained based on a signal received by said the position detector (220) (Figure 1; page 3, paragraphs 0036, 0037).

With regard to claim 22, the microphone (150) disclosed in Bates et al. is considered as the data obtaining device as claimed.

With regard to claim 23, as represented herein above, the memory (230) is the claimed storage unit, and that the combination of volatile memory and non-volatile memory for storing location information (geographic region) and parameters to go along with each geographic location. The keypad (120) represented above herein includes a variety of keys for user to select either a location information or data from different pre-stored location information, and data stored in the memory (230) (page 2, paragraphs 0032, 0034). The position detector (220) is the claimed receive unit, which is provided for determining the geographic position of the portable phone. Bates et al. further teach the following: the storage unit (230) that stores the location data and correlates the data with the received location information received from the unit (220) (Bates et al, page 3, paragraph 0036). When a user who carrying the portable phone to a new location that is different from the location information, the data belongs to that location would be retrieved. Bates et al. also disclose a display (130) for notifying a user of the information the data that belongs to a geographic location that has been stored in the portable phone. Thus, Bates et al. additionally discloses the limitation: "an information notification unit to notify a user of the portable information terminal of information

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corresponding to the extracted data. In addition, the microphone (150) is considered as the data obtaining device as claimed in the present invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (US 20010055974A1) and in view of Stewart (US 6049718A).



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With respect to claims 7 and 8, Bates et al. explicitly disclose the limitations of claims 1 and 4 except for that "the location information is a base station code of a base station with which the portable information terminal is communicating".

The US reference to Stewart, as represented herein, discloses a portable telephone comprising: a storage (50) for storing location code, which is the base station code of a base station as claimed in the present invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Bates et al. to include the teachings as taught by Stewart so that the location data of a base station is generated correspondingly from the base station code which station is communicating to a portable telephone.

### ***Conclusions***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

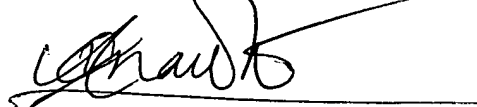
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner,

A handwritten signature in black ink, appearing to read 'Tuan C To', is written over a horizontal line.

Tuan C To

October 4, 2005